

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of: Akseli ANTTILA <i>et al.</i>	Confirmation No.: 7848
Application No.: 10/017,654	Group Art Unit: 2451
Filed: December 12, 2001	Examiner: Kamal B Divecha

For: SYNCHRONOUS MEDIA PLAYBACK AND MESSAGING SYSTEM

Commissioner for Patents
Alexandria, VA 22313-1450

REPLY BRIEF

Dear Sir:

This Reply Brief is submitted in response to both the Examiner's Answer mailed October 27, 2009 and to the Supplemental Examiner's Answer mailed December 21, 2009.

Based on Appellants' understanding, the only difference between the Examiner's Answer and the Supplemental Answer is that the latter adds an additional three references under the heading of "Evidence Relied Upon" at page 3 and one of the names of the conferees at page 44 has been changed. Other than these minor changes, the Answer of October 27, 2009 and the Supplemental Answer of December 21, 2009 are substantially identical.

Accordingly, where reference is made, below, to the "Answer," it refers to either one or both the Answer and/or the Supplemental Answer, and when reference is made, below, to page numbers in the "Answer," the page numbers refer to either one or both the Answer and/or Supplemental Answer.

I. STATUS OF THE CLAIMS

Claims 1-19, 23-25, 30-33, 36, and 39-47 are pending in this appeal, in which claims 20-22, 26-29, 34, 35, 37, and 38 were canceled. No claim is allowed. Claims 1-19, 23-25, 30-33, 36, and 39-47 are on appeal from the Final Rejection of December 16, 2008.

II. GROUND OF REJECTION TO BE REVIEWED

Claims 1, 2, 4-6, 8-19, 23-25, 30-33, and 42-45 were rejected for obviousness under 35 U.S.C. § 103(a) based on *Liou et al.* (WO 9946702) in view of *Dalrymple et al.* (US 6,976,094), *Handley et al.* (RFC 2327), and *Vilander* (US 7,193,987).

Claims 36, 39, 46, and 47 were rejected for obviousness under 35 U.S.C. § 103(a) based on *Liou et al.* (WO 9946702) in view of *Dalrymple et al.* (US 6,976,094), *Kumar et al.* (US 6,006,253), and *Vilander* (US 7,193,987).

Claim 40 was rejected for obviousness under 35 U.S.C. § 103(a) based on *Liou et al.* (WO 9946702) in view of *Dalrymple et al.* (US 6,976,094), *Handley et al.* (RFC 2327), *Vilander* (US 7,193,987), and *Kumar et al.* (US 6,006,253).

Claim 7 was rejected for obviousness under 35 U.S.C. § 103(a) based on *Liou et al.* (WO 9946702) in view of *Dalrymple et al.* (US 6,976,094), *Handley et al.* (RFC 2327), *Vilander* (US 7,193,987), and *Crandall et al.* (US 2002/0107040).

Claims 3 and 41 were rejected for obviousness under 35 U.S.C. § 103(a) based on *Liou et al.* (WO 9946702) in view of *Dalrymple et al.* (US 6,976,094), *Handley et al.* (RFC 2327), *Vilander* (US 7,193,987), and *Agresta et al.* (US 2002/0091848).

The rejection of claims 1-19, 23-25, 30-33, 36, and 39-47 under 35 U.S.C § 112, first paragraph, based on an inadequate written description, has been withdrawn by the Examiner in the Answer. Therefore, this ground of rejection is no longer on appeal.

III. ARGUMENT

Appellants maintain and incorporate the positions presented in the Appeal Brief filed July 14, 2009, but present further refutation of certain assertions presented in the Examiner's Answer.

Regarding the rejection of claims 1, 2, 4-6, 8-19, 23-25, 30-33, and 42-45 under 35 U.S.C. § 103(a) based on *Liou et al.* (WO 9946702) in view of *Dalrymple et al.* (US 6,976,094), *Handley et al.* (RFC 2327), and *Vilander* (US 7,193,987), the caption of argument "B," at page 16 of the principal Brief, inaccurately stated that none of the applied references disclose a **"MEDIA PLAYBACK INVITE REQUEST INCLUDING A PLAYBACK OPTION ENABLING THE GUEST WIRELESS TERMINAL TO REQUEST DIFFERENT TYPES OF PLAYBACK OPTIONS IN CONNECTION WITH PLAYBACK OF THE IDENTIFIED MEDIA FILE."** As correctly noted by the Examiner, at page 19 of the Answer, **"OPTIONS"** should, of course, have been **"ACTIONS."** The body of the arguments in the principal Brief accurately reflects this.

At page 17 of the principal Brief, Appellants argued that none of the applied references "discloses or suggests this single invite request that includes 'information sufficient to **identify at least one guest wireless terminal**, an **identification of a pre-existing playable media file**, and a **playback option** enabling the guest wireless terminal **to request different types of playback actions** in connection with playback of the identified media file'." At page 20 of the Answer, the Examiner cites paragraphs [25] and [31] of Appellants' specification and, based on this, argues,

at page 21 of the Answer, that one of the playback options may comprise inputting and/or sending the textual comment from a user, i.e., inputting and sending the data such as text comment from a user. Appellants note this observation by the Examiner but fail to see any relevance since it is true that one of the playback actions that a guest wireless terminal is enabled to effect is, indeed, the sending of a text message. However, this does not refute Appellants' argument that none of the applied references discloses a single invite request, wherein that invite request includes "information sufficient to **identify at least one guest wireless terminal**, an **identification of a pre-existing playable media file**, and a **playback option** enabling the guest wireless terminal to **request different types of playback actions** in connection with playback of the identified media file."

At pages 21-27 of the Answer, the Examiner merely discusses the disclosures of the *Liou et al.*, *Dalrymple et al.*, and *Handley et al.* references, acknowledging that *Liou et al.* does not disclose the functionalities of an invite request including all of the claim features, i.e., "information sufficient to **identify at least one guest wireless terminal**, an **identification of a pre-existing playable media file**, and a **playback option** enabling the guest wireless terminal to **request different types of playback actions** in connection with playback of the identified media file." However, the Examiner asserted that such functions are "typical processes of a SIP protocol" and that SIP protocols are well known, as established in RFC 2543 and incorporated into *Dalrymple et al.* Mere generalities about what a "typical process" would be in a SIP protocol fall far short of what is required to establish a *prima facie* case of obviousness. For all the posturing by the Examiner as to what a typical process would be in a SIP protocol, the Examiner has failed to offer specific evidence of an invite request including "information sufficient to **identify at least one guest wireless terminal**, an **identification of a pre-existing playable**

media file, and a **playback option** enabling the guest wireless terminal **to request different types of playback actions** in connection with playback of the identified media file.”

Moreover, even if the SIP protocol would permit such functions, there would have been no reason, other than impermissible hindsight gleaned from Appellants’ disclosure, to apply those very specifically claimed functions in the dynamic video annotation system of *Liou et al.* To the extent that *Dalrymple et al.* may employ the SIP protocol to invite, or “re-INVITE” (col. 5, lines 51-62) participants to join a session, there is no disclosure or suggestion in *Dalrymple et al.* that an INVITE request would include “information sufficient to **identify at least one guest wireless terminal**, an **identification of a pre-existing playable media file**, and a **playback option** enabling the guest wireless terminal **to request different types of playback actions** in connection with playback of the identified media file,” as claimed. Col. 4, lines 20-31, of *Dalrymple et al.*, reproduced at page 24 of the Answer, discloses a proxy server 18 accepting an INVITE request from a caller computer and contacting a location service server 20 with all or part of the caller’s address to determine specific address information for the invited callee computer. The location service server 20 returns a specific address identifying the callee computer 10 to the proxy server 18. The proxy server 18 then issues an INVITE request to the callee computer 10 based on that specific address. Thus, while one terminal may be identified (by address), there is no suggestion that an INVITE request may include “an **identification of a pre-existing playable media file**, and a **playback option** enabling the guest wireless terminal **to request different types of playback actions** in connection with playback of the identified media file,” as claimed. The portion of RFC 2543, reproduced at the bottom of page 25 of the Answer, does not provide for these deficiencies.

At pages 28-29 of the Answer, the Examiner argued that since claim 1 recites “a playback option **enabling** the guest wireless terminal to request different types of playback actions...,” this suggests that the playback option allows/permits the guest terminal to request different types of action requests. Then, citing various passages of *Handley et al.*, RFC2327, at pages 7-8 and 22-23, the Examiner concludes, at page 31 of the Answer, that the “a=recvonly,” “a=sendrecv,” and “a=sendonly” options enables/allows/permits and/or disables/disallows the guest terminal to send data/command/instructions enabled by the “a=xxxx” option. The Examiner gives specific examples, as where if “tools are started in sendonly mode, the host terminal may not allow the guest terminal to send any data/requests/instructions such as comments, requests, etc.” and where “the tools are started in “sendrecv mode, the host terminal allows the guest terminal to send the data, wherein if the guest terminal can send data **implies** that the guest terminal can send any requests and/or instruction with respect to comments.” Appellants respectfully disagree.

As stated in the principal Brief, the “a=sendrecv” field described in *Handley et al.* is not a playback option enabling the guest wireless terminal to request different types of playback actions **in connection with playback of a pre-existing playable media file**. Rather, the “a=sendrecv” instruction in *Handley et al.* merely specifies that “tools” should be started in a “send and receive mode.” Specifically, *Handley et al.* identify a whiteboard, “wb” application as a tool that might be employed during a multimedia conference conducted via the Internet. To whatever extent there is any transmission from or receipt to the whiteboard application, there is no indication in *Handley et al.* that this transmission or receipt would be a request related to playback of a pre-existing media file, as claimed.

The Examiner appears to acknowledge, at page 34 of the Answer, that *Handley et al.* fails to disclose any of the data or modes of operation “in connection with playback of a pre-existing

playable media file” by referring back to *Liou et al.* for a teaching of playback of a pre-existing media file, and referring to a tenuous connection of an SDP, employed in a SIP protocol, in *Dalrymple et al.*, as identifying a media file.

Even if the references taught all that the Examiner alleges, and Appellants do not agree that they do, it would clearly be only through hindsight that the skilled artisan would combine disparate teachings of a SDP identifying a media file in *Dalrymple et al.*, with the playback of a pre-existing media file in *Liou et al.* and then, somehow, force-fit an alleged implication by *Handley et al.* of a guest terminal sending requests and/or instruction into the *Liou et al./Dalrymple et al.* combination. There would have been no cogent rationale for making this combination in the manner alleged by the Examiner and the Examiner has provided no such cogent rationale.

Moreover, contrary to the Examiner’s position, the sending of “data,” *per se*, does not **imply** that a terminal also sends requests or instructions.

At page 35 of the Answer, the Examiner contends that the instant claims on appeal do not require the media file to be at the guest terminal. While the claims may not explicitly recite such, it is clearly implied by the claim language that this is the location of the pre-existing playable media file. The purpose of the invite request and acceptance is to determine if the guest desires to accept the invitation request and whether the media file exists at the guest terminal. The guest terminal will request download of the media file before acceptance of the invitation request if that media file does not already exist at the guest terminal. Therefore, it should be clear that the media file must be at the guest terminal (either pre-existing at or downloadable to) before acceptance of the invitation request. The reason that an invite request is issued is to invite guest terminals to participate in enjoyment of the media file. If the guest terminal accepts the invitation

but the media file is not at, or brought to, the guest terminal, then the guest terminal cannot enjoy the media contained in that file, so it is clear that the media file must be at the guest terminal before the invited guest can enjoy it.

At page 37 of the Answer, the Examiner contends that Appellants are addressing the references individually because Appellants are attacking the lack of a pre-existing media file in *Handley et al.* when *Liou et al.* teaches such a file. On the contrary, Appellants are attacking the motivation for making the alleged combination of references since there would have been no reason to apply any alleged requests in *Handley et al.* to include a request “in connection with playback of a pre-existing playable media file.” In fact, the Examiner’s rejection appears to be no more than hindsight reconstruction of the claimed features using a hodge-podge of bits and pieces of disclosure from a variety of unrelated references. Such a rationale constitutes clear error, within the meaning of 35 U.S.C. § 103(a) and the Honorable Board is respectfully requested to reverse the Examiner’s rejections based on this clear error.

With regard to dependent claim 39, Appellants asserted that the feature of “modifying the identified media file in accordance with a modification file during the playback session” is not disclosed or suggested in the applied references and that claim 39 was separately patentable apart from independent claim 36. At pages 39-40 of the Answer, the Examiner took the position that since *Liou et al.* teaches changing the video play speed during a playback session of video content, with the “video player including modification file such as annotation control file having annotation functions, attached tools, frame rate file having frame rate control functionality, etc.,” the claimed feature of claim 39 is met. Appellants respectfully disagree.

For all the “modification” of video speed, jumping to different frames, and video annotation described at pages 7 and 11 of *Liou et al.*, these are modifications to how video

content is displayed to a user. It has nothing to do with modifying the “media **file**,” especially in accordance with a “**modification file**,” as claimed. Therefore, none of the applied references provides for the features of claim 39. Accordingly, the Honorable Board is respectfully requested to reverse the Examiner’s rejection of claim 39 even if the Board sustains the rejection of independent claim 36.

At pages 40-42 of the Answer, the Examiner addresses Appellants’ arguments relating to a lack of adequate motivation or suggestion to make the proposed combinations of references. Appellants rely on their arguments in the principal Brief, particularly at pages 25-26 thereof.

In arguing Appellants’ assertion that the rejections are based on hindsight, the Examiner cites *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385(2007) for the proposition that various methods of analysis under 35 U.S.C. § 103(a) may be employed. However, *KSR* is not a magic cloak to be tossed over an applicant’s claims, mysteriously nullifying such claims by an Examiner’s subjective test as to what would have been obvious. There must still be some “articulated reasoning with some rational underpinnings” presented by the Examiner in order to reach the conclusion of obviousness within the meaning of 35 U.S.C. § 103. No such “articulated reasoning with some rational underpinnings” has been presented by the Examiner in this case, for the reasons above and for the reasons set forth in the principal Brief.

IV. CONCLUSION AND PRAYER FOR RELIEF

Appellants, therefore, request the Honorable Board to reverse each of the Examiner's rejections.

Respectfully Submitted,

DITTHAVONG MORI & STEINER, P.C.

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Date

/Phouphanomketh Ditthavong/
Phouphanomketh Ditthavong
Attorney for Applicant(s)
Reg. No. 44658

Errol A. Krass
Attorney for Applicant(s)
Reg. No. 60090

918 Prince Street
Alexandria, VA 22314
Tel. (703) 519-9952
Fax (703) 519-9958